

1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
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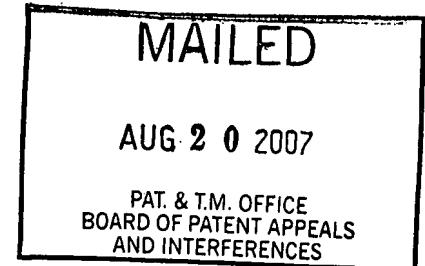
10 Ex parte SHINJI MORIYAMA,
11 YOSHIHIRO FUKUSHIMA,
12 and HIDENORI TACHI
13

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15 Appeal 2007-1855
16 Application 10/815,650
17 Technology Center 1700
18

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20 Oral Hearing Held: July 11, 2007
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23 Before CHUNG K. PAK, CHARLES F. WARREN,
24 and LINDA M. GAUDETTE,
25 Administrative Patent Judges
26

27 ON BEHALF OF THE APPELLANT:

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Appeal 2007-1855
Application 10/815,650

1 The above-entitled matter came on for hearing on Wednesday,
2 July 11, 2007, commencing at 9:05 a.m., at the United States Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah
4 Rinaldo, RPR, Notary Public, CCR No. 0315067.

5 THE CLERK: This is calendar number 13. Appeal number
6 2007-1855. The attorney is Mr. Harris Pitlick.

7 MR. PITLICK: Good morning.

8 JUDGE PAK: We have two interns today who are going to
9 observe the hearing. We have a court reporter, Debbie Rinaldo, who is
10 going to transcribe the entire hearing, and the transcript will become part of
11 the record, as you know. And you have 20 minutes to start your case and
12 you may start any time you wish.

13 MR. PITLICK: Okay. Shouldn't take 20 minutes, but of course
14 I don't know how many questions you might have.

15 What we have here is a toner with an activated carbon
16 component, and the invention here has to do with the volume average
17 median size of the activated carbon and the coefficient of variation.

18 Essentially, the rejection is one over this Machida reference.
19 As we pointed out in the various briefs, Machida, et al., disclosed and
20 suggests nothing about coefficient of variation, nor is it possible to reverse
21 engineer Machida and figure out what the coefficient of variation is of their
22 materials.

23 So we've argued that Machida is insufficiently enabling and that
24 this case is different from the traditional case where there is a case made on
25 inherent anticipation, which is the case the examiner has made here.

1 In those cases it was possible to take the disclosure in the prior
2 art and determine whether the particular mutation that was being asserted for
3 patentability actually existed in that prior art. It's impossible to do that in
4 this case.

5 As we've indicated in the declaration of record, it certainly
6 appears that this commercial product is sold in a much greater particle size
7 and it has to be pulverized. And basically we've done everything we really
8 can in this case to get as much information we could about the product, and
9 yet again it's impossible to make any comparison with that product.

10 And as I say, I think the primary reference here, Machida, is
11 hopelessly, insufficiently disclosed.

12 JUDGE WARREN: We know one thing, Counselor, and that is
13 -- well, perhaps you could answer us this. The translation has one product
14 name. You come in and the declarations say that the product is really
15 something else by a different chemical company.

16 In your spec you have a similar trade name at specification page
17 4, line 16. You have Shirasagi KA-2 in paragraph 3 and in your declaration
18 is Shirasagi A-1.

19 You have it by Machida where your declarant says, well, it's
20 really now Japan EnviroChemicals, Ltd., which looks like the case when you
21 all filed your application, it was already Japan EnviroChemicals. Are we
22 sure that what the translation should have said is what you say it is?

23 MR. PITLICK: Well, first of all, in terms of the name
24 Shirasagi and whatever the term that was used in Machida, again, this is an
25 English translation of an original Japanese text. I don't think there is any
26 issue that Shirasagi is correct and the name that was used in the reference --

1 JUDGE WARREN: So in other words, the Shirasagi in your
2 specification is actually produced by Takeda Chemical, and in your
3 declaration it is actually produced by Japan EnvrioChemicals, Limited.

4 MR. PITLICK: Yeah. There is actually no issue as to the
5 manufacturer of these things. I'm not sure whether our materials needed to
6 be pulverized in order to get the coefficient of variation.

7 JUDGE WARREN: There is no indication in your spec that it
8 had to be.

9 MR. PITLICK: My point is, the fact is that the product that
10 we're aware of that the reference has is sold in, I think it was, approximately
11 39-point-something microns and it has to be pulverized.

12 Whether ours had to be pulverized or not really is irrelevant.
13 The issue really is, can we actually compare to what the reference discloses?
14 And we can't.

15 JUDGE WARREN: Let me ask you this. If you all were sure
16 that what you have in the paragraph 7 of your declaration was the same
17 product that's used in the reference and the reference says that it pulverized
18 it down to one micrometer, why wouldn't that fall within your claim even
19 though we don't have a Coulter counter assessment of it so that we can get
20 your coefficient of variation which is based on that medium particle size
21 D50?

22 The two are related.

23 MR. PITLICK: No, they are not. They are not related. They
24 are totally independent. The coefficient of variation has nothing to do with
25 the particle size.

26 JUDGE WARREN: Your specification says it does.

1 MR. PITLICK: I wish you would show me where it does. I
2 don't believe it does.

3 JUDGE WARREN: It says over here on specification 13 that
4 the coefficient of variation CV is essentially the standard deviation divided
5 by D50 times 100.

6 MR. PITLICK: I understand that. That just tells you how it's
7 calculated.

8 JUDGE WARREN: That's absolutely correct.

9 MR. PITLICK: But the fact is, you can have the same particle
10 size and you can have many different coefficients of variation.

11 JUDGE WARREN: So why didn't your -- since we're only
12 looking at the toner here, what prevented your declarant from taking what he
13 says is the same product that's in the reference, pulverizing it to one
14 micrometer, which falls within your claim, take your Coulter counter, which
15 apparently is within the assignee's possession, determine the D50 and then
16 run the CV off of that?

17 MR. PITLICK: I'm sorry, but I'm not following you. The fact
18 is, depending on how you pulverize it, you can get lots of different CVs.

19 JUDGE WARREN: That's absolutely true.

20 MR. PITLICK: So how do we know what the reference did in
21 order to get their particle size?

22 JUDGE WARREN: Since you chose not to pulverize it down
23 to 1.0 and see what that did for you --

24 MR. PITLICK: I don't understand -- I'm sorry. I don't
25 understand where you are coming from on the 1.0.

1 JUDGE WARREN: The reference has -- and I'll tell you the
2 table. After working example 3 on page 12, two particle sizes, toner 1 has a
3 4.5 micrometer; toner 6 has 1.0 micrometer. It would appear that both of
4 those particle sizes would have a D50 falling within your claims.

5 MR. PITLICK: Well, I might add, again, the reference talks
6 about average particle diameter. Our claim is basically the volume average
7 median. And I realize we haven't pressed this argument because we think
8 the coefficient of variation argument is a lot more significant. But there is
9 certainly a difference there, too, in terms of how you are measuring the
10 particle size.

11 But again, even if our people had made a one-micron -- tried to
12 produce activated carbon with one micron diameter, again, depending on
13 how you did it, you could have a coefficient of variation either above or
14 below what we have in our claims.

15 How would you know? The reference doesn't tell you how they
16 made it. All we can presume -- and there is no evidence going the other way
17 -- is they had a bulk material and they pulverized it, and at least in toner 1
18 they had 4.5 average particle diameter; toner 6 average particle diameter of
19 1.0. That's all we know about it. Nothing else.

20 JUDGE WARREN: So then we're to assume that whatever the
21 bulk was that you obtained for this particular product in 2004 would have a
22 D50 of about 39.605 micrometers, what your declarant says -- well, he
23 thinks it should be about the same measurement as would be obtained with
24 the Coulter counter.

25 MR. PITLICK: Yes. I mean, you know, it's a declaration. He's
26 got 18 U.S. Code 1001. It hasn't been challenged. Again, you got to do

1 what you can. I mean, this reference is -- I think it goes back to the '80s. It's
2 not a U.S. patent. There is no presumption of correctness here or that it's
3 accurate.

4 As a matter of fact, just as an aside, when you think about it,
5 every reference, every piece of prior art is really hearsay. And for the most
6 part we allow that to come in because the applicant always has the
7 opportunity to challenge something that's in the prior art.

8 If they say X and you carry out -- try to carry out what the prior
9 art says and you get Y, that's an indication there is something wrong and you
10 can make that argument. You can't do that here.

11 JUDGE WARREN: But you didn't carry out what the prior art
12 did.

13 MR. PITLICK: Of course we did. We did as much as what the
14 prior art told us. The prior art told us they -- all they told us is they had
15 these toners of certain particle size. They didn't tell us how they made it. I
16 mean, we had to speculate how they made it. We don't know. And there is
17 absolutely no way to reproduce this prior art and determine what the
18 coefficient of variation is.

19 JUDGE WARREN: I will say it again. On page 12 of the
20 reference it says, other than the fact that in the composition of working
21 example 1, the average particle diameter of the activated carbon was
22 changed to 1.0 micrometer.

23 According to table 3 in working example 1, the activated
24 carbon particle has a diameter of 4.5 micrometers.

25 MR. PITLICK: I'm sorry, where are you reading?

26 JUDGE WARREN: Page 12, the translation.

1 MR. PITLICK: That's where I am. I don't see that.

2 JUDGE WARREN: I don't find in your declaration, or perhaps
3 if I overlooked it, you could point it out to me, where you pulverized this
4 product that you say is essentially the same thing to these particular particle
5 diameters, average particle diameters.

6 MR. PITLICK: Well, we did -- you know, we certainly did one
7 that was 5.59 microns, which is just within the terms of our claim, yet it had
8 a coefficient of variation, as I recall, 88 percent.

9 JUDGE WARREN: I'm not going to quibble with what the
10 example thinks of that particular structure.

11 MR. PITLICK: But the fact is, Judge Warren, we don't think
12 there is a prima facie case here. So whatever we did, I suppose is, I think,
13 could be looked at as icing on the cake.

14 The bottom line here is this reference is insufficiently disclosed.
15 We've done the best we could, the best that was possibly available to us to
16 try to reproduce what the reference has. Again, I know I'm repeating myself,
17 but there is absolutely no way to determine what the coefficient of variation
18 is in this reference. No way.

19 I would also like to point out again, we pointed out in the brief
20 that the examiner has improperly treated subject matter that we've
21 discovered and used that as admissions.

22 Obviously there are certain indications where admissions can be
23 used but not when we talk about -- we discovered certain things and we've
24 gotten certain data. I won't repeat all the arguments we've made there. I
25 think they are legitimate.

1 JUDGE PAK: Counsel, under In re Best, when the product
2 appears to be identical or substantially identical, then burden can be shifted
3 to the applicant to come up with some evidence to establish patentability of
4 that particular product.

5 MR. PITLICK: I'm not aware of In re Best. I agree that --

6 JUDGE PAK: In that context that the examiner could compare
7 what's in the specification with the prior art to show there are some level of
8 correspondence to establish a prima facie case of either same identity or
9 virtual identity, enough to -- even though they are silent as to certain
10 properties, they can shift burden to the appellant because presumably,
11 according to In re Best, you guys have the choice to test these things,
12 whereas the Patent Office doesn't.

13 MR. PITLICK: I have no problem with In re Best. Certainly In
14 re Best is the law, but there is certainly a difference between taking things
15 that we've discovered and treating them as admissions versus saying, well,
16 these appear to be the same or pretty similar and we shift the burden.

17 We've accepted the burden even though we don't necessarily
18 agree that we had the burden. But we've accepted the burden and we've
19 shown that there is no way to show that the reference has what we have.

20 There is no way -- I mean, as we said in the brief, one skilled in
21 the art could carry out Machida and have problems and would not know why
22 it didn't work. They could not know why it didn't work.

23 Now, perhaps it didn't work because the coefficient of variation
24 was different. Perhaps it didn't work for some other reason. You know, the
25 examples are not identical.

1 Could be a particular resin binder that they used, perhaps. The
2 working examples in the reference has a few other additional components.
3 Maybe the offset preventing additive or the electrostatic control agent had
4 something to do in this case.

5 As we've indicated, no statistician certainly -- and we don't even
6 have to go that far -- would compare the data in the reference and our data
7 and say you can really compare them. There are too many variations.

8 But again, even if you could say that the reason for the
9 difference is only coefficient of variation, how would you know? How
10 would you know? It's not like we're removing something from the prior art
11 that was already there.

12 One would never know and that's why I'm making that
13 distinction between this case and the traditional inherent anticipation cases
14 where you can go back and check to see, Well, does the prior art actually
15 have that limitation? You cannot do it in this case.

16 JUDGE WARREN: So instead of In re Best, perhaps In re
17 Skoner applies.

18 MR. PITLICK: I don't remember exactly what Skoner says.

19 JUDGE WARREN: Skoner said that just because you didn't
20 describe your invention in terms not in the prior art doesn't necessarily make
21 it patentable.

22 MR. PITLICK: I can't comment because I have not reviewed
23 Skoner.

24 JUDGE WARREN: I have one other question on this matter of
25 admissions. It doesn't seem like the examiner is using the parts in your

1 specification as one would if they were making an admission and relying on
2 it as prior art.

3 It appears that what the examiner has done is to use parts of
4 your specification to try and judge whether what is disclosed in the
5 specification falls within your claim. Do you consider that to be an
6 improper use in your specification?

7 MR. PITLICK: Not necessarily. I'm looking for the particular
8 passages that she relied on.

9 JUDGE WARREN: She relied on page 3, lines 10 to 16; page
10 11, line 23 to page 12, line 1 and table 1.

11 MR. PITLICK: Well, 10 to 16, it's our discovery.

12 JUDGE WARREN: That's true, it is.

13 MR. PITLICK: Our discovery. And we've discovered -- again,
14 we're talking about the volume base median particle size. Not the average
15 particle size.

16 JUDGE WARREN: I think she understands that, but I think
17 what the goal here is to say that, well, if you are saying that you get these
18 results, if your coefficient of variation exceeds 80 percent and the reference
19 doesn't evidence that those results were obtained or if they are particular to
20 working examples in that table on page 12, then she said one would
21 reasonably expect the materials that they used in those two working
22 examples fell within your claims.

23 MR. PITLICK: Well, again, I don't think you can call it an
24 admission. Whatever you want to call it, it's not an admission.

25 But, again, this is our discovery. And while it might show that
26 if everything else were identical, while it might show that the reference

1 meant our coefficient of variation, again, it would be no way to ascertain
2 that. Absolutely no way.

3 And so if you treat it as an admission where -- you know, it's
4 like saying we're admitting that the reference has that coefficient variation,
5 and we're not admitting that at all.

6 JUDGE PAK: Counsel, I don't think Judge Warren indicated
7 examiner is relying on that part of the specification as admitted prior art.
8 Rather, the examiner is using those portions of the specification for the
9 comparative purpose which examiner has right to do in trying to establish a
10 similarity between the identity of your claim and the prior art composition.

11 MR. PITLICK: Well, perhaps the problem is the language that
12 was used. Her language. But, again, I've said this often today, and you
13 would never know this by reading the reference and trying to reproduce the
14 reference, you would never know the coefficient of variation was important,
15 significant, had any effect. That's the primary defect in these rejections.

16 JUDGE WARREN: I have no further questions.

17 JUDGE PAK: Thank you for coming.

18 (Whereupon, the proceedings at 9:26 a.m. were concluded.)